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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,943

03/23/2006

Julian De La Azuela

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EXAMINER

LITHGOW, THOMAS M

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

12/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,943	Applicant(s) DE LA AZUELA ET AL.	
	Examiner Thomas M. Lithgow	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-41 is/are pending in the application.
- 4a) Of the above claim(s) 31, 34 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-30, 32-33 and 36-41 are is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of A.filter -- I. Separating means in a downstream container and -- "valve controlled" in the reply filed on 01 Sept 2009 is acknowledged. Claims 31 and 34-35 are non-elected as a result of the restriction and election.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 18, 20, 24, 26, 30 and 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 63-258606. JP '606 discloses a fuel filter having a filter housing 2, defining a bottom outlet and a water absorbing membrane 7 located in a container 4 which is mounted to the filter housing 2. The membrane absorbs water and prevents fuel from

exiting via the outlet defined by the bottom extension of house 2 or the outlet conduit 10 from container 4. The membrane 82 acts as a valve to discharge water.

4. Claims 18, 21, 24, 26-30, 32 and 38-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Harenbrock (US 6893571). As noted herein, the US patent version (US 6893571) is applied against the claims. A review of the declarations filed under 35USC131 is appropriate. The declaration of the three inventors indicate the work done leading up to the conception of the invention was done in a WTO member country (Germany) but fails to establish that such work was done after 1 January 1996. Applicant redacted dates as indicated but that necessitates the use of a bottom date guideline as above indicated. Additionally, rule 131 does not apply to references which are claiming the same subject matter and at least a couple of applicant's independent claims are coming extremely close to the scope of the claims presented in Harenbrock '571. As such, the rule 131 declarations are not currently accepted to remove Harenbrock '571 as a reference against the claims. Harenbrock '571 discloses a fuel filter 10 having a valve 14 controlled water outlet line 12 leading to an accumulator which functions to adsorb the vestiges of the hydrocarbon fuel

from the water to be discharged. Applicant asserts that the claim 18 language "... and the container is mounted on the filter housing" defines over Harenbrock '571 (or previous Harenbrock '860). It is noted that applicant's claim 25, which is dependent upon claim 18, is only supported by the figure 1 drawing (embodiment) includes a conduit 9 between outlet 5 and container 11. As applicant intends this arrangement to be "mounted on the filter housing" as evidenced by claim 25, then Harenbrock's arrangement with conduit 12 must similarly be regarded as "mounted on the filter housing". Applicant may want to consider the language "mounted directly to the filter housing" and then not include claims that read on the fig. 1 embodiment, and then argue that "mounted directly to" includes only a configuration like fig. 5.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 18-20, 32, 38-39 and 41 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious

over Kasten (US 3368681) alone or further in view of Kasten (US 2864505). Kasten '681 discloses a fuel filter 14 in his fuel purification process and directly references Kasten '505 as disclosing the specifics of fuel filter 14 [see col. 3, lines 1-4]. Such a direct reference would constitute the entire disclosure of Kasten '505 as incorporated with the disclosure of Kasten '681. If later determined otherwise, it would have been obvious to employ the specific fuel filter of Kasten '505 for the fuel filter 14 in Kasten '681 based on a direct reference therein. In Kasten '505 there is a fuel filter (see fig. 1-2 embodiment) with a fuel inlet 18, fuel outlet 20, various filters 38, 34 and 50, sump 16 and an automatic control valve (not shown- col. 1, line 66+]. Kasten '681 further discloses device 16 (see fig. 2) down stream of the water outlet 30 of the fuel filter for separating contaminants from the water to be drained off. As indicated earlier, "mounted to" and "adjoining" are considered broadly in view of applicant's claim language.

1. Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harenbrock '571 as applied to claim 18 above, and further in view of Bradford (US 5951862). Harenbrock '571 is silent as to which side of his fuel filter his water sump is "associated" with. Bradford '862 discloses his water sump 44 is "associated" with the clean side of his

fuel filter. To so operate Harenbrock's fuel filter would have been obvious to one of ordinary skill in the art.

2. Claims 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harenbrock '571 as applied to claim 18 above, and further in view of Amini (US 5879543). Harenbrock '571 is silent as to which side of his fuel filter his water sump is "associated" with. Amini '543 discloses his water sump on the dirty (prefilt) side of his fuel filter. To so operate the Harenbrock '571 fuel filter would have been obvious to one of ordinary skill in the art.

3. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harenbrock '571 as applied to claim 24 above, and further in view of Hall (US 4334989). Although the adsorption evaporator of Harenbrock '860 is open to the environment [0035] it is unclear if it is open in its upper region. Hall '989 teaches that such an arrangement to evaporate water removed from a fuel filter. Specifically, see vent openings 84 from retainer 72. To so modify the evaporator of Harenbrock '571 to facilitate the removal of excess water would have been obvious to one of ordinary skill in the art.

4. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Harenbrock '571 or JP '606 or Kasten '681 as applied to claim 18 above, and further in view of any one of Gough (US 3868321) or McVay (US 3508658) or Muller (US 3685655). The use of a float actuated valve discharge to remove water from the sump of a fuel filter is well known and taught by any one of the above three patents. To employ such float regulated valves for their intended purpose would have been obvious to one of ordinary skill in the art.

7. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Harenbrock '571 or JP '606 or Kasten '681 as applied to claim 18 above, and further in view of any one of Jackson (US 4264442) or Davis (US 4539109) or Yasuhara (US 4491143). The use of two sensors to sense the water level in a fuel water separator is well known and taught by any of the three patents above. To use such a known control system for its intended use would have been obvious to one of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Lithgow whose

telephone number is 571-272-1162. The examiner can normally be reached on Mon. -Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas M. Lithgow/

Primary Examiner, Art Unit 1797

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Art Unit 1797

TML